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Attorney Docket No. LCB398

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jack E. Caveney)
Serial No.: 10/613,062) Art Unit: 3677
Filed: July 3, 2003) Examiner: Jack W. Lavinder
For: Ball Lock Cable Tie Having)
Stiffening Ribs)

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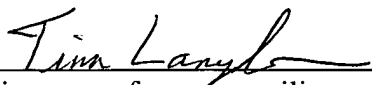
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Date of Deposit: February 21, 2006

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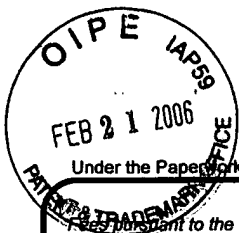
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2) Appeal Brief (16 pgs.) and
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PTO/SB/17 (01-06)

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FEE TRANSMITTAL

For FY 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

Complete if Known

Application Number	10/613,062
Filing Date	July 3, 2003
First Named Inventor	Jack E. Caveney
Examiner Name	Jack W. Lavinder
Art Unit	3677
Attorney Docket No.	LCB398

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 16-0228 Deposit Account Name: Panduit Corp.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

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☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50
Each independent claim over 3 (including Reissues)	200
Multiple dependent claims	360

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP =	x	=	

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	x	=	

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	=	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Fee for Filing a Brief in Support of an Appeal Under 37 CFR 41.20(b)(2)

Fees Paid (\$)

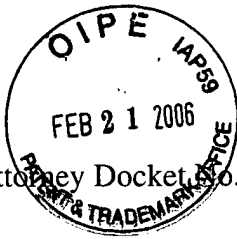
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SUBMITTED BY

Signature	<u>Christopher S. Clancy</u>	Registration No. (Attorney/Agent) 44,618	Telephone 708-532-1800
Name (Print/Type)	Christopher S. Clancy		Date February 20, 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Applicant:	Jack E. Caveney)	
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Serial No.:	10/613,062)	Art Unit: 3677
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For:	Ball Lock Cable Tie Having)	
	Stiffening Ribs)	

APPEAL BRIEF

Mail Stop Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner Lavinder:

Submitted herein is Applicant's Appeal Brief as required by 37 CFR 41.37 and an authorization to pay the fee for filing a brief in support of an appeal under 37 CFR 41.20(b)(2).

02/23/2006 MAHMED1 00000022 160228 10613062

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(i) **Real Party in Interest**

Per an assignment recorded for the above-identified application on July 3, 2003, Panduit Corp. is the real party in interest.

(ii) **Related Appeals and Interferences**

None.

(iii) Status of Claims

Claims 7-12 and 20-24 stand rejected, and claims 1-6 and 13-19 have been canceled. Claims 7-12 and 20-24 are being appealed.

(iv) **Status of Amendments**

No amendments have been filed in the above-identified application subsequent to the final office action mailed September 15, 2005.

(v) **Summary of Claimed Subject Matter**

Independent claim 7 requires an elongate metallic strap 28 having a first end 26 and a second end 30 opposite the first end 26, a hooked portion 34 formed integral with the first end 26 and a return loop connecting the first end 26 to the hooked portion 34, wherein the return loop includes at least one rib 38 disposed thereon. As best seen in FIGS. 1 and 6, and described in specification paragraph [0030], the return loop connects the first end 26 of the strap 28 to the hooked portion 34, and the return loop includes at least one rib 38.

(vi) **Grounds of Rejection to be Reviewed on Appeal**

Whether claims 7-9, 11-12 and 20-24 are unpatentable under 35 U.S.C. 103 (a) over *Blanks* (U.S. 5,732,446) in view of *Andersen* (U.S. 6,035,495) and *Sauer* (U.S. 4,300,270).

Whether claim 10 is unpatentable under 35 U.S.C. 103(a) over *Blanks* in view of *Andersen* and *Sauer*, and further in view of *Thurston* (U.S. Re25,769).

(vii) **Argument**

Claims 7, 10-12 and 20-24

The Examiner rejected claims 7-9, 11-12 and 20-24 under § 103(a) as being unpatentable over *Blanks* (U.S. 5,732,446) in view of *Andersen* (U.S. 6,035,493) and *Sauer* (U.S. 4,300,270). The Examiner also rejected claim 10 under § 103(a) as being unpatentable over *Blanks* in view of *Andersen* and *Sauer*, and further in view of *Thurston* (U.S. Re25,769). Claims 7, 10-12 and 20-24 will be argued as a group and, thus, dependent claims 10-12 and 20-24 stand or fall with independent claim 7. For the reasons discussed below, Applicant submits that claims 7, 10-12 and 20-24 are patentable over *Blanks*, *Andersen*, *Sauer* and/or *Thurston*, taken alone or in combination.

Independent claim 7 recites ". . . an elongate metallic strap having a first end and a second end opposite the first end, a hooked portion formed integral with the first end and a return loop connecting the first end to the hooked portion, wherein the return loop includes at least one rib disposed thereon." As best seen in FIGS. 1 and 6, the return loop connects the first end 26 of the strap 28 to the hooked portion 34, and the return loop includes at least one rib 38 disposed thereon. Applicant submits, and the Examiner admits, that neither *Blanks*, *Andersen*, *Sauer* nor *Thurston*, taken alone or in combination, disclose a cable tie having a return loop connecting one end of a strap to an integral hooked portion, with the return loop including at least one rib disposed thereon.

In the Office Action, the Examiner contends that *Andersen* discloses using a reinforcing rib (13) on a return loop (12', figure 1) to strengthen the hose clamp. Thus, the Examiner contends that it would have been obvious to one of ordinary skill in the art to add strengthening ribs to *Blanks*' metal tie band, to increase the strength of the tie band and to improve the

reliability of the tie band. The Examiner further contends that the motivation arises from what the references would teach one of ordinary skill in the art.

In applying 35 U.S.C. §103(a), the Patent Office must: 1) consider the claimed invention as a whole; 2) consider the references as a whole when determining whether the references suggest the desirability of making a combination; 3) consider the references without the benefit of impermissible hindsight consideration of Applicant's disclosure; and 4) use a reasonable standard of success as the standard from which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143, 229 USPQ 182, 187 (Fed. Cir. 1986).

In this case, it appears that the Examiner is not looking at the invention "as a whole", but instead is improperly focusing on the differences between the claims and the references (*i.e.*, providing stiffening ribs on the return loop of a cable tie). However, patent case law is clear that in considering the differences, the question is not whether the differences themselves would have been obvious, but rather whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Distilling an invention down to the gist of the invention disregards the requirement of analyzing the subject matter "as a whole." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983, *cert. denied*, 469 U.S. 851 (1984)). In addition, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art. *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 220 USPQ 97, 99-100 (Fed. Cir. 1983). The invention must be considered "as a whole."

In order to consider the invention "as a whole", however, the Examiner must view the context in which the invention was made, problems solved by the invention and the like. See *In*

re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) where it was held that in delineating the invention as a whole, one looks “not only to the subject matter literally recited in the claims . . . but also to the properties of the subject matter which are inherent in the subject matter and are disclosed in the specification.” *Also see In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) where it was found that the discovery of the source of a problem is also part of the “subject matter as a whole” inquiry. The Examiner has not made this inquiry.

In this regard, the claimed invention is directed to a stainless steel ball lock cable tie. As discussed in paragraph [0003] of the Background of the Invention, metallic bundling devices incorporating locking balls and roller pins have been used for bundling bales of cotton or the like since the Nineteenth Century. Such metal cable ties are known to one of ordinary skill in this art (*i.e.*, the field of cable ties), in addition to plastic cable ties. It is also well known to one skilled in this art that it would be desirable to increase the tensile strength and, thus, increase overall performance of a cable tie. However, Applicant submits that *Andersen* would teach nothing to one of ordinary skill in the cable tie art because one of ordinary skill in the cable tie art would not be motivated by any teachings of a one-piece, circular hose clamp, when determining how to improve cable tie performance. Thus, it would not have been obvious to add reinforcing ribs to the metal tie band of *Blanks*. Accordingly, Applicant submits that claim 7 is patentable over the cited prior art. Claims 10-12 and 20-24 are asserted to be allowable based on their dependency from allowable claim 7.

Claim 8

Applicant submits that dependent claim 8 is patentable over *Blanks*, *Andersen* and/or *Sauer*, taken alone or in combination, for at least the reasons discussed above regarding

independent claim 7. Moreover, Applicant submits that claim 8 is patentable, separate and apart from independent claim 7, for the reasons discussed below.

As shown in Figs. 2 and 6, the return loop includes two ribs 38 disposed thereon. Applicant submits, and the Examiner admits, that neither *Blanks*, *Andersen* nor *Sauer*, taken alone or in combination, disclose a cable tie having a return loop connecting one end of the strap to an integral hooked portion, with the return loop including at least two ribs disposed thereon. Accordingly, Applicant submits that claim 8 is patentable over *Blanks*, *Andersen* and/or *Sauer*, taken alone or in combination.

Claim 9

Applicant submits that dependent claim 9 is patentable over *Blanks*, *Andersen* and/or *Sauer*, taken alone or in combination, for at least the reasons discussed above regarding independent claim 7. Moreover, Applicant submits that claim 9 is patentable, separate and apart from independent claim 7, for the reasons discussed below.

As shown in Figs. 10-13, and described in specification paragraph [0034], locking head 24 includes a lead-in portion 60 at the strap entry face 48. The lead-in portion 60 facilitates the initial insertion of tip 62 into the locking head 24 and reduces installation time for threading the cable tie 22. Moreover, the lead-in portion 60 strengthens the top of the locking head 24. As strap 28 enters the strap entry face 48, the strap engages the lead-in portion 60 and the strap is biased toward floor 54.

In his September 15, 2005 Final Office Action, the Examiner contends that *Blanks* discloses all of the limitations of Applicant's claimed invention except for a rib disposed along the return loop and indentations in the opposite sides of the head. Thus, Applicant assumes that

the Examiner contends that *Blanks* discloses a locking head including lead-in portion at the entry face. However, the Examiner does not identify any structure in *Blanks* that corresponds to lead-in portion 60 in the present application, and for good reason. *Blanks* does not disclose, teach or suggest a locking head including lead-in portion at the entry face. Accordingly, Applicant submits that claim 9 is patentable over *Blanks*, *Andersen* and/or *Sauer*, taken alone or in combination.

(viii) **Claims Appendix**

7. A cable tie, comprising:

an elongate metallic strap having a first end and a second end opposite the first end, a hooked portion formed integral with the first end and a return loop connecting the first end to the hooked portion, wherein the return loop includes at least one rib disposed thereon;

a metallic locking head secured to the first end of the strap for receiving the second end of the strap, the head comprising a strap entry face, a strap exit face, and a strap-receiving aperture extending therebetween, the head further comprising a floor and a roof which diverge in the direction of the exit face; and

metallic roller means for lockingly engaging the strap, the head comprising retention means disposed adjacent the exit face for captively holding the roller means within the head,

the roller means being movable between a threading position wherein the roller means is disposed adjacent the exit face and the retention means, and a locking position wherein the roller means is closer to the entry face.

8. The cable tie of claim 7 wherein the return loop includes two ribs disposed thereon.

9. The cable tie of claim 7 wherein the head further comprises a lead-in portion at the entry face.

10. The cable tie of claim 7 wherein the strap is coated.

11. The cable tie of claim 7 wherein the roller means comprises a ball.
12. The cable tie of claim 7 wherein the retention means comprises a finger extending from the roof adjacent the exit.
20. The cable tie of claim 7 wherein the head comprises at least one indentation on a first side thereof.
21. The cable tie of claim 20 wherein the head further comprises at least one indentation on a second side thereof.
22. The cable tie of claim 20 wherein the head comprises two indentations on the first side thereof.
23. The cable tie of claim 20 wherein the head comprises two indentations on the first side thereof.
24. The cable tie of claim 20 wherein the head comprises two indentations on the second side thereof.

(ix) **Evidence Appendix**

None.

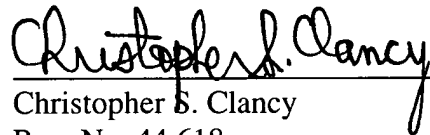
(x) **Related Proceedings Appendix**

None.

Dated: February 20, 2006

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Respectfully submitted,

A handwritten signature in black ink, reading "Christopher S. Clancy", is written over a horizontal line.

Christopher S. Clancy
Reg. No. 44,618
Attorneys for Applicant